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23165 7590 01/05/2009 ROBERT J JACOBSON PA 650 BRIMHALL STREET SOUTH ST PAUL, MN 551161511				
EXAMINER				
ZIMMER, MARC S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Concerning Applicants' statements against the rejection of Fukumoto, their emphasis is on the fact that Fukumoto does not disclose pre-emulsification of the monomer prior to its addition to the polysiloxane particles. Applicant is reminded, however, that claim 7 is a product-by-process claim and "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Although the Examiner acknowledges that there is no explicit mention of a pre-emulsification of the monomer, there can be no argument against the fact that the reference characterizes the relationship between the particles and monomer as one of the monomer being impregnated inside the particles. Therefore, the particle obtained upon polymerization of the monomer would inherently possess a narrow particle size distribution and, thus, it appears that there is no patentable distinction between the resin composition of the prior art and that which is claimed. Later, the Applicant remarks that Fukumoto does not disclose the excellent effects identified in the instant Specification. However, these effects are not claimed and, even if they were, the claiming of a new use, new function or unknown/undocumented property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

As for the rejections over Kuramoto, Applicant makes the following comment regarding the teachings of paragraph [0054]:

Thus, paragraph [0054] of Kuramoto discloses that a radical polymerization is carried out in the presence of a surfactant.

and then concludes:

Hence, Kuramoto, like Fukumoto, does not disclose or suggest that the monomer itself is previously emulsified before impregnation and before polymerization.

Respectfully, the Examiner does not see how the latter conclusion may be drawn from the former observation. In the Examiner's estimation, the skilled artisan, upon reading paragraph [0054] would appreciate that the surfactant can be added to (i) the particle dispersion prior to introducing the monomer, or (ii) to the monomer before it is combined with the particles, or both. Given the limited number of possibilities for different sequences of addition of the surfactant, it is the Examiner's position that this aspect is still anticipated or, at the very least, rendered obvious. Moreover, were Applicant to argue that the more appropriate rejection was under 35 U.S.C. 103(a), an idea that the Examiner does not acquiesce to, the method claims would still not be allowable because the realization of a product with a narrow particle size distribution is predicted in the prior art. See the paragraph bridging columns 1 and 2 of Hattori et al., U.S. Patent # 5,216,096 and column 4, line 67 through column 5, line 43.

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796

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